

REMARKS/ARGUMENTS

Claims 1, 3-17, 19-25, 27-31 and 33-37 are pending in the present application. In the Office Action mailed November 28, 2005, the Examiner rejected claims 1, 3-17, 19-25, 27-31 and 33-37 under 35 U.S.C. § 103.

Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

I. Objection to Claim 1

As part of the amendments submitted herein, claim 1 has been amended to address the typographical error raised by the Examiner. Withdrawal of this claim objection is respectfully requested.

II. Rejection of Claims 1, 3-17, 19-24, 31 and 33-37 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 3-17, 19-24, 31 and 33-37 under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,634,114 to Shipley (hereinafter, "Shipley") in view of U.S. Patent No. 6,185,734 to Saboff et al. (hereinafter, "Saboff") and further in view of U.S. Patent No. 5,590,056 to Barritz (hereinafter, "Barritz"). This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the

references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims. In the present case, independent claims 1, 17 and 31 have been amended to recite that “the conflict between the selected application program and the software code is confirmed after the execution of the software code has been detected.” This claim element is not disclosed or suggested by any of the cited references. The only reference that arguably teaches anything related to a step of “confirming the conflict” is Shipley. *See* Office Action, p. 2-3. However, the Office Action asserts that Shipley teaches “that the conflict...is confirmed after the software code is loaded....” Office Action, p. 3.¹ To the extent that Shipley teaches that the confirming step occurs after the software code is loaded, it clearly does not that the confirming occurs after the code is executed. On the contrary, the purpose of Shipley’s reference is to determine and “confirm” a conflict between the software versions so that the non-preferred version will not be executed or used by the DLL. *See* Shipley Col. 7, lines 12-18 (prior to the software code being executed/used, “the DLL discovers that the preferred version [of the application program] is not supported” at which point ... “the DLL returns to the application a ‘not OK’ or ‘preferred version not supported’ flag” so that the version will not be executed/used); *see also* Shipley, Col. 7, lines 12-55.

As explained in the prior Office Action Response, Shipley will never have a situation in which the conflict between the software code and the application program is confirmed after the time in which the loading or execution of the software code is detected by the system. Page 3 of the Office Action quoted part of the last Office Action Response that included a typographical error.

¹ It should be noted that Applicants strongly disagree with the Examiner’s interpretation of Shipley on this issue. However, even under the Examiner’s interpretation of Shipley, the present amendments distinguish the claims from the cited art, and thus, Applicant will not raise these arguments in the present paper. Of course, if further

Applicants point out that, in the first full paragraph on page 16 of the last Office Action Response, the terms “prior to” should have been replaced by “after”. It is clear from the arguments and amendments in the last Office Action Response that Applicants were taking this position. “Therefore, because Shipley (or any of the other cited references) fails to teach or disclose a system in which the confirming step occurs after the loading or execution of the software code has been detected, this combination of references cannot render independent claims 1, 17, 25, and 31 prima facie obvious under 35 U.S.C. §103(a).” Office Action Response dated September 12, 2005, first full paragraph on page 16.

In view of the foregoing, Applicants respectfully submit that independent claims 1, 17 and 31 are patentably distinct from the cited references. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn.

Claims 3-16 depend, either directly or indirectly, from independent claim 1. Likewise, claims 19-24 depend, either directly or indirectly, from independent claim 17. Finally, claims 33-37 depend, either directly or indirectly, from independent claim 31. Accordingly, Applicants respectfully request that the rejection of these dependent claims based upon the combination of Shipley, Saboff, and Barritz be withdrawn for at least the same reasons as those presented above in connection with claims 1, 17 and 31.

III. Rejection of Claims 25 and 27-30 Under 35 U.S.C. § 103(a)

As noted above, these claims are not obvious unless all of the limitations found in the claims are taught or suggested by the prior art. *See* MPEP §2143. In the present case, independent claim 25 includes the limitation that “the conflict between the selected application program and the software code is confirmed after the execution of the software code has been detected.” As explained above, this limitation is not taught or suggested by either Shipley, Saboff or Barritz. Likewise, Applicants can find no teaching in Yinger that relates to this limitation. Accordingly, because none of the cited

prosecution on this case is necessary, Applicants reserve the right to raise these issues later.

Appl. No. 09/915,862
Amdt. dated February 28, 2006
Reply to Office Action of November 28, 2005

references teach or suggest this limitation, this combination of references does not render claim 25 prima facie obvious under 35 U.S.C. § 103(a). Withdrawal of this rejection is respectfully requested.

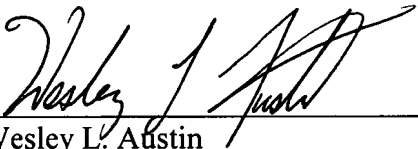
Further, with respect to claims 27-30, these claims depend, either directly or indirectly, from independent claim 25. Accordingly, Applicants respectfully request that the rejection of these dependent claims based upon the combination of Shipley, Saboff, Barritz and Yinger, be withdrawn for at least the same reasons as those presented above in connection with claim 25.

Thus, for the foregoing reasons, Applicants respectfully request that the above-recited rejections be withdrawn.

IV. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Wesley L. Austin', is written over a horizontal line.

Wesley L. Austin
Reg. No. 42,273
Attorney for Applicant

Date: February 28, 2006

MADSON & AUSTIN
Gateway Tower West
15 West South Temple, Suite 900
Salt Lake City, Utah 84101
Telephone: 801/537-1700